

REMARKS/ARGUMENTS

Claims 67-80 and 82-84 are currently pending in the application. Entry of the current amendment is requested to cancel claim 71, and to make the amendments as set forth hereinbefore. The Examiner has rejected claims 67-80 and 82-84. Applicant addresses the Examiner's comments in the order made.

Support for the amendment to claim 67 may be found at paragraphs 26, 29 and 31 of the published application. Support for the amendment to claims 72 and 74-77 may be found at paragraph 29 of the published application.

1. The Examiner has rejected claims 67-80 and 82-84 pursuant to 35 USC 112, first paragraph. The Examiner asserts that the specification, while being enabling for a method that includes analyzing a sample of cells by introducing the cells into an embryo of an oviparous teleost fish species that has not yet developed an immune system that would subject the cells to rejection, allegedly does not provide enablement for carrying out the claimed method in "any viviparous teleost fish species."

While not agreeing with the Examiner's rejection and the characterization of the scope of enablement provided by the specification, Applicants have amended independent claim 67 and dependent claims 72 and 74-77 to recite "zebrafish," which the specification expressly identifies as being "externally fertilized." Applicants submit that the current amendment addresses the Examiner's allegation that the specification does not enable "any viviparous teleost fish species," and this ground of rejection should be withdrawn.

Applicants have further amended claim 67 to address the Examiner's rejection pursuant to 35 USC 112 as it pertains to the immune system of a zebrafish embryo. Specifically, applicants have added language to clarify that the zebrafish embryo "has not yet developed an immune system that would subject the cell or population of cells to immune rejection" (*i.e.*, to the extent that this would prevent performance of the claimed methods).

Applicants submit that entry of the current amendments place claims 67-70, 72-80, and 82-84 in condition for allowance, and entry of the amendment is respectfully requested.

2. The Examiner has rejected claim 83 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 16, 33 and 40 of US Patent No. 6,761,876 (the '876 patent). The Examiner asserts that the claim is drawn to a method of testing an antineoplastic procedure that is generic to and encompasses the administration of an agent as claimed in the '876 patent. Applicants respectfully disagree.

Applicants submit that, as a dependent claim, claim 83 would not have been obvious in light of claims 1, 16, 33, and 40 of the '876 patent for the same reasons that all other pending claims in the present application would not have been obvious in light of the '876 patent. Claim 83 includes all of the limitations of the claims from which it depends, including "detecting a property of the ... population of cells to indicate whether ... the population of cells comprises a cancer cell" as recited in Claim 67. Thus, claim 83 is not only directed to testing an antineoplastic procedure but also requires determining whether the transplanted sample contains cancerous cells. The latter step is not recited in the '876 patent claims.

For these reasons, applicants respectfully submit that the double-patenting rejection is not applicable to claim 83 for the same reason as it is not applicable to other claims.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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